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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,065	11/12/2003	Michael Sittinger	27600/X014A	6362
29471 7590 11/19/2008 MCCRACKEN & FRANK LLP 311 S. WACKER DRIVE SUITE 2500 CHICAGO, IL 60606				
EXAMINER				
NICHOLSON III, LESLIE AUGUST				
ART UNIT		PAPER NUMBER		
3651				
MAIL DATE		DELIVERY MODE		
11/19/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/706,065

Applicant(s)

SITTINGER ET AL.

Examiner

LESLIE A. NICHOLSON III

Art Unit

3651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-68 is/are pending in the application.
- 4a) Of the above claim(s) 56-68 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 10/14/2008 have been fully considered but they are not persuasive.

Applicant argues "such additional control functions are not disclosed by the cited art, and are not available in the conventional controllers disclosed thereby" and none of the prior art cited by the examiner, either along or in combination, teaches or suggests "a controller that controls the operation of a gathering line, feeding device, and a demand printer as recited by claims 1-35,43-48, and 55" or "a step of coordinating simultaneous operation of a gathering line, a demand printer, and a feeding device during a production sequence to produce books as recited by claims 36-42 and 49-54". In response, the Examiner disagrees. The prior art cited discloses all the limitations of the claims as shown in at least the Action filed 7/14/2008 and as shown below. Furthermore, the Examiner notes that Applicant admits the cited art "inherently includes a speed tracking device that receives timing information from a binding line to enable the ink jet head to synchronize the printing speed thereof with the speed of the binding line". Therefore, in the combinations as shown below, it is obvious to one having ordinary skill in the art that the demand printer would be able to synchronize the printing speed with the speed of the book production apparatuses of the cited art. Warmus discloses a substantially similar book production apparatus in at least C1/L12-21, discloses a demand printer employed in a book production apparatus in at least C2/L41-

57, and therefore must be able to synchronize the printing speed with the speed of the book production apparatus. Finally, it is well known in the art for a gathering line, a printer, and a feeding device to be coordinated simultaneously in operation during a production sequence to produce books. The individual elements of book production apparatuses in at least the cited prior art are not operated one at a time.

Applicant argues "the examiner has not stated any reasons why a person of ordinary skill in the art would have been prompted to combine any of the cited art to arrive at the subject matter recited by the claims at issue". In response, the Examiner disagrees. The motivation to combine the references is to permit high speed printing to the production of differing books with customized and/or personalized information within a single production run, as taught by Warmus in at least C4/L4-8, shown in at least the Action filed 7/14/2008 in ¶¶5,6,7 and as shown below..

Applicant argues "the cited art, along or in combination, does not disclose or suggest each of the elements recited by the claims at issue". In response, the Examiner disagrees. The cited art discloses or suggests each of the elements recited by the claims at issue shown in at least the Action filed 7/14/2008 and as shown below.

Applicant argues "there is no suggestion that a person of ordinary skill in the art could have successfully combined any of Graushar, Dooley, or Weller with Warmus et. al. '599 or '968 to arrive at the subject matter recited by claims at issue. Specifically, a combination of a well known controller with the demand printers of the Warmus et. al. '599 or '968 as suggested in the Office action would not result in a book production apparatus as recited by the claims at issue. Rather, such combination would result in an

inoperable device or a device that would be unable to coordinate the operation of the gathering line, one or more demand printer(s), and the feeding device to produce books. Therefore, it follows that the claimed subject matter is not rendered obvious by the cited art". In response, the Examiner disagrees. It is obvious to one having ordinary skill in the art that the combination of Warmus with Graushar, Dooley, or Weller would result in a book production apparatus as recited by the claims at issue and would result in an operable device that can coordinate the operation of the gathering line, one or more demand printer(s), and the feeding device to produce books. As discussed above, Warmus discloses a substantially similar book production apparatus in at least C1/L12-21, discloses a demand printer to be used in a book production apparatus in at least C1/L10-C4/L12, namely C2/L41-57, and therefore must be able to synchronize the printing speed with the speed of the book production apparatus. Therefore, it would be obvious to provide the demand printer of Warmus in the book production apparatuses of Graushar, Dooley, and Weller.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1,2,8,9,13,23,24,30,31,35,55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dooley USP 6,257,566 in view of Warmus USP 6,327,599.

Dooley discloses a book production device that includes a gathering line (14); a printer (56); a feeding device (58); a packer box (16) with a transfer mechanism (C4/L3); and a controller (60). Dooley does not expressly disclose the printer being that of a demand printer or means for printing the customized content on at least a portion of each page without limitation as to the orientation and position of the customized content over an entire surface of the page.

Warmus teaches a demand printer (C6/L25) and means for printing the customized content on at least a portion of each page without limitation as to the orientation and position of the customized content over an entire surface of the page (at least C7/L36-49, fig.6-8) for the purpose of permitting high speed printing to the production of differing books with customized and/or personalized information within a single production run (C4/L4-8).

At the time of invention it would have been obvious to one having ordinary skill in the art to employ means for printing the customized content on at least a portion of each page without limitation as to the orientation and position of the customized content over an entire surface of the page and modify the printer to be that of a demand printer, as taught by Warmus, in the device of Dooley, for the purpose of permitting high speed printing to the production of differing books with customized and/or personalized information within a single production run.

4. Claims 1,2,12-16,20,22-24,35-38,43-45,49-51,55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graushar USP 5,100,116 in view of Warmus USP 6,327,599.

Graushar discloses a book production device that includes a gathering line (18); a plurality of printers (32, C4/L51); a feeding device (33); and a controller (31). Graushar does not expressly disclose the printers being that of demand printers or means for printing the customized content on at least a portion of each page without limitation as to the orientation and position of the customized content over an entire surface of the page.

Warmus teaches demand printers (C6/L25) and means for printing the customized content on at least a portion of each page without limitation as to the orientation and position of the customized content over an entire surface of the page (at least C7/L36-49, fig.6-8) for the purpose of permitting high speed printing to the production of differing books with customized and/or personalized information within a single production run (C4/L4-8).

At the time of invention it would have been obvious to one having ordinary skill in the art to employ means for printing the customized content on at least a portion of each page without limitation as to the orientation and position of the customized content over an entire surface of the page and modify the printer to be that of demand printers, as taught by Warmus, in the device (or method) of Graushar, for the purpose of permitting high speed printing to the production of differing books with customized and/or personalized information within a single production run.

5. Claims 1,2,6,7,12-18,20,22-24,28,29,35-38,41,43-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weller USP 4,989,850 in view of Warmus USP 6,327,599.

Weller discloses a book production apparatus that includes a gathering line (90); a plurality of printers (75, C5/L1-6); a feeding device (GR); a folding device (C4/L56); and a controller (C3/L56). Weller does not expressly disclose the plurality of printers being that of demand printers or means for printing the customized content on at least a portion of each page without limitation as to the orientation and position of the customized content over an entire surface of the page.

Warmus teaches demand printers (C6/L25) and means for printing the customized content on at least a portion of each page without limitation as to the orientation and position of the customized content over an entire surface of the page (at least C7/L36-49, fig.6-8) for the purpose of permitting high speed printing to the production of differing books with customized and/or personalized information within a single production run (C4/L4-8).

At the time of invention it would have been obvious to one having ordinary skill in the art to employ means for printing the customized content on at least a portion of each page without limitation as to the orientation and position of the customized content over an entire surface of the page and modify the printers to be that of demand printers, as taught by Warmus, in the device (or method) of Weller, for the purpose of permitting

high speed printing to the production of differing books with customized and/or personalized information within a single production run.

6. Claims 3-5,25-27,39,40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graushar USP 5,100,116 in view of Warmus USP 6,327,599 further in view of Warmus USP 5,963,968.

Graushar discloses all the limitations of the claims, but it does not disclose utilizing a template file having fixed and variable information separated into data streams and provided to a collator/raster image processor together with a database and a press command file.

However, Warmus ('968) discloses a book production device that includes disclose utilizing a template file having fixed and variable information separated into data streams and provided to a collator/raster image processor together with a database and a press command file for the purpose of producing differing book versions in an efficient manner (C3/L8-10).

It would have been obvious for a person of ordinary skill in the art at the time of the applicant's invention to modify Graushar by utilizing a template file having fixed and variable information separated into data streams and provided to a collator/raster image processor together with a database and a press command file, as disclosed by Warmus ('968), for the purpose of producing differing book versions in an efficient manner.

7. Claims 10,11,14,17,19,32-34 rejected under 35 U.S.C. 103(a) as being unpatentable over Dooley USP 6,257,566 in view of Warmus USP 6,327,599 further in view of Weller USP 4,989,850.

Dooley discloses all the limitations of the claims, but it does not disclose a folder and it does not disclose a plurality of demand printers.

However, Weller discloses a book production device that includes a folder for the purpose of processing signatures which have not been folded (C3/L4-6) and Weller discloses utilizing a plurality of demand printers for the purpose of customizing more than one page.

It would have been obvious for a person of ordinary skill in the art at the time of the applicant's invention to modify Dooley by utilizing a folder and a plurality of demand printers, as disclosed by Weller, for the purpose of processing signatures which have not been folded and customizing more than one page.

8. Claims 14,21,36,42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dooley USP 6,257,566 in view of Warmus USP 6,327,599 further in view of Graushar USP 5,100,116.

Dooley discloses all the limitations of the claims, but it does not disclose a plurality of demand printers.

However, Graushar discloses a book production device that includes a plurality of demand printers for the purpose of customizing more than one page.

It would have been obvious for a person of ordinary skill in the art at the time of the applicant's invention to modify Dooley by utilizing a plurality of demand printers, as disclosed by Graushar, for the purpose of customizing more than one page.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **LESLIE A. NICHOLSON III** whose telephone number is (571)272-5487. The examiner can normally be reached on M-F, 8:30 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Crawford can be reached on 571-272-6911. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gene Crawford/
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/L. A. N./
Examiner, Art Unit 3651
11/14/2008